

290. (New) The currency evaluation device of claim 295 wherein the means for flagging is adapted to cause the transport mechanism to halt after a suspect bill has been delivered to an output receptacle of the second set.

291. (New) The currency evaluation device of claim 295 wherein the means for flagging is adapted to cause the transport mechanism to halt with a suspect bill positioned at an identifiable location in an output receptacle of the second set.

292. (New) The currency evaluation device of claim 295 wherein the means for flagging is adapted to cause the transport mechanism to halt with a suspect bill being the last bill transported to an output receptacle of the second set.

293. (New) The currency evaluation device of claim 218 wherein the transport mechanism is adapted to transport bills at a rate of at least 1,000 bills per minute. --

REMARKS

Claims 164-261 are pending in the application. Claims 164-170, 175-183, 199, 205-213, 216-217, 223-226, 237-242, 246-250, and 256-259 have been cancelled without prejudice. The Applicant reserves the right to pursue these claims in another application. Thus, claims 171-174, 184-198, 200-204, 214-215, 218-222, 227-236, 243-245, 251-255, and 260-261 remain in the application. Dependent claims 171, 184, 189, 200, 214, 227, 234-236, 243, 244 and 260 have been amended to their independent form, including intervening dependencies, if any. New dependent claims 262-293 have been added to the application. No new matter has been entered. Reconsideration of the claims in view of the following remarks is respectfully requested.

Supplemental Information Disclosure Statement (IDS)

The Applicants are submitting herewith a Supplemental Information Disclosure Statement (IDS). The Applicants would respectfully request that the Examiner review these references and make them of record.

35 U.S.C. §103(a) Rejections

As acknowledged in the Office Action, “Saito fails to disclose the step of stopping the sort operation of the devise specifically on a non-piece count criterion”. Saito, thus, does not disclose, *inter alia*, the following features recited in the independent claims of the present invention.

Claims 171, 184, 189 and 200 recite a “processor being adapted to cause the transport mechanism to halt in response to a determination that a bill meets or fails to meet at least one of the criteria.” Claim 214 recites a “means for flagging a bill . . . wherein the means for flagging is adapted to cause the transport mechanism to halt when a bill whose denomination has not been determined is encountered.” Claim 218 recites a “means for flagging a bill . . . wherein the means for flagging is adapted to cause the transport mechanism to halt when the discriminating unit determines that a bill is suspect.” Claims 227 and 234-236 recite a “processor programmed to flag bills meeting or failing to meet any of non-piece count criteria . . . wherein the processor is adapted to cause the transport mechanism to halt with a flagged bill meeting or failing to meet at least a given set of the criteria being positioned in one of the output receptacles.” Claims 243 and 244 recite a “flagging device . . . adapted to generate a stopping signal in response to the no call signal and wherein the transport drive motor is adapted to stop in response to the stopping signal.” Claim 251 recites a “flagging device . . . adapted to

generate a stopping signal in response to the suspect signal and wherein the transport drive motor is adapted to stop in response to the stopping signal.” Claim 260 recites “a processor programmed to cause the transport mechanism to halt in a predetermined manner in response to a determination that a bill meets a stranger bill criterion and in response to a determination that a bill meets a no call bill criterion.”

Saito only discloses stopping its device under three circumstances: (a) if the money placed in the input receptacle is exhausted, or (b) if the device is manually stopped, or (c) when the number of notes have reached a predetermined limit. The Office Action mentioned the first circumstance at column 9, lines 14-16 (“When the mount 2 becomes vacant, the pulse motor KPM is stopped (step 122), to stop the conveyer drive motors HPM1 and HPM2 in a predetermined time”), and column 11, lines 34-40. The second circumstance is a manual stopping and is disclosed at column 6, lines 26-29 of Saito. (“A stop key STP is used to stop the sorting processing when pushed down. This stop key is used when the conveyer system is clogged with notes or in the similar case.”). The third circumstance is disclosed at column 14, lines 39-42. Thus, Saito does not disclose, *inter alia*, the above-recited features of the independent claims.

Furthermore, Saito teaches away from such claimed features. First, as discussed above, Saito discloses continuous movement of the transport mechanism until a certain number of bills have been evaluated. Second, Saito discloses that after the discrimination unit discriminates the notes, the transport mechanism conveys them to their corresponding containers, without stopping. *See* column 8, lines 35-49. Specifically, Saito discloses a “seventh container S7...provided for accommodating or receiving notes or the like which have been discriminated or determined to be abnormal at the

discrimination unit 7.” See column 4, lines 29-32. Thus, Saito discloses that bills which have been determined as abnormal are off-sorted to a seventh container without any mention of halting the transport mechanism in response to a bill whose denomination has not been determined. Third, Saito teaches that abnormal notes are inspected after the entire batch of notes has been processed. Column 10, line 56 to column 11, line 12. Fourth, Saito discloses that it is inconvenient for an operator of the machine to continuously attend the machine. Column 1, lines 20-21.

Additionally, it is acknowledged in the Office Action that “Saito fails to disclose a device that sorts bills at a rate of at least 800 bills per minute and the Office Action has applied Conant for such a teaching. Such a feature is recited in several independent claims (claims 171, 184, 189, 227, and 234-236) of the present invention. There, however, is no teaching or suggestion that the Saito device can operate at a rate of 800 bills per minute, let alone at 1000 bills per minute. There is no teaching or suggestion that the devices of Saito and Conant can be combined together. For example, the device of Saito shown in FIG. 1b has a lengthy transport path with seven output receptacles, while the Conant device as shown in FIG. 1 has a much shorter and less complicated transport path than Saito with two output receptacles.

Therefore, a *prima facie* case of obviousness has not been made and independent claims 171, 184, 189, 200, 214, 218, 227, 234-236, 243, 244, 251, and 260 should be in a condition for allowance over Saito, Conant or the combination thereof. Claims 172-174, 185-188, 190-198, 201-204, 215, 219-222, 228-233, 245, 252-255 and 261-293, which depend directly or indirectly on one of the above-identified independent claims, should

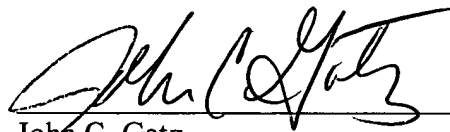
also be allowable over Saito, Conant or the combination thereof, for at least those reasons.

CONCLUSION

The Applicants submit that the claims are in a condition for allowance and action toward that end is earnestly solicited. The commissioner is hereby authorized to charge deposit Account No. 10-0447 (47171-00262USC2) for any fees inadvertently omitted which may be necessary now or during the pendency of this application, except for the issue fee.

Dated: August 9, 2002

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John C. Gatz", is written over a horizontal line.

John C. Gatz
Reg. No. 41,774
JENKENS & GILCHRIST, P.C.
225 West Washington Street, Suite 2600
Chicago, Illinois 60606
312.425.3900

Attorney for Applicants